

REMARKS

Claims 1-13 are pending in the application. The specification has been revised to correct an obvious typographical error. Claim 1 has been revised to more clearly define the aspect of the invention that relates to the lack of an adhesive coating on the smooth side of the claimed film. That is, the smooth side of the claimed film is not an adhesive coating, nor is an adhesive coating applied thereto. Support for the amendment can be found throughout the specification and original claims, *inter alia*, at page 4, para. 0010, page 5, para. 0013, page 6, para. 0014, page 8, para. 0025, etc. New claims 14 and 15 have been added, and are fully supported by the specification and examples, at pages 11 and 12, para. 0013, and page 15, para. 0043. No new matter is presented by the amendments. Accordingly, applicants respectfully request entry thereof and reconsideration of claims 1-15 in light of the following remarks.

On page 2 of the Action, claims 1-13 are rejected under 35 U.S.C. §112, second paragraph. Specifically, the Action alleges that the recitation “does not have an adhesive coating” renders the claim indefinite. Applicants respectfully traverse this rejection.

Applicants appreciate the Examiner’s concerns with respect to the definition of adhesive, and respectfully submit that the smooth surface recited in the present claims is adhesive in nature since the claims also require the smooth surface to be capable of removably adhering to a textured surface. The smooth surface of the claimed film, in contrast the primary reference cited by the Examiner, is not formed by coating an adhesive composition onto a base film. Rather, the smooth surface is one side of a two-sided film formed by methods typically employed to form films, e.g., extrusion, etc. Thus, the smooth surface is not itself an adhesive coating, nor does it have an adhesive coating applied thereto. The smooth surface instead is a smooth side of a film that has adhesive properties.

Applicants believe that the amendments to the claims clarifying their scope, coupled with the foregoing arguments, render the claims sufficiently clear. Applicants are

amenable to alternative language to define the aspects of the invention outlined above. Accordingly, should the amendments and arguments not fully convince the Examiner to withdraw this rejection, applicants courteously encourage the Examiner to propose alternative language to define these aspects of the invention. In light of the above, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

On pages 3-6 of the Action, claims 1-4, and 6-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gotoh, *et al.*, U.S. Patent No. 5,286,781 ("Gotoh") in view of Harvie, *et al.*, U.S. Patent No. 5,693,405 ("Harvie"). Applicants respectfully traverse this rejection.

Gotoh teaches away from the claimed invention by disclosing a pressure sensitive adhesive coating composition. The adhesive composition of Gotoh is applied as a coating layer on a base film, and is not a film by itself, nor is there any enabling disclosure in Gotoh suggesting how the adhesive composition could be formed into a film without coating onto a base film. The present specification describes a number of disadvantages associated with the use of an adhesive coating, such as those disclosed in Gotoh. These disadvantages include, for example, susceptibility to moisture from humidity and liquids, escalated adhesion upon exposure to heat or extended aging, and excess processing steps required in forming the coating (page 2, para. 0004 of the present specification). By not using an adhesive coating as disclosed in Gotoh, the present invention provides an improved masking film that does not suffer from one or more of the aforementioned disadvantages associated with the use of an adhesive coating.

Gotoh requires its adhesive composition to be coated onto a base film, such as kraft paper, fabric or thermoplastic resin films (col. 3, lines 30-35). Coating can either be by melting and coating (example 1, col. 7, lines 26-37) or co-extrusion with a thermoplastic resin such as a polyolefin (col. 6, lines 7-10 and the examples).¹ The presently claimed

¹ While it is true that Gotoh discloses co-extrusion of the adhesive composition, Gotoh does not disclose or suggest forming a film of the adhesive composition by itself, without coating on a base film, or co-

masking film specifically excludes the adhesive compositions of Gotoh by reciting a masking film that is not itself an adhesive coating, or that does not have an adhesive coating applied thereto. Applicants therefore respectfully submit that the combination of prior art fails to render obvious the claimed invention.

A person skilled in the art would not have combined Gotoh with Harvie, as suggested in the Action. The Action combines the two documents “so that the film [of Gotoh] does not block on a roll or wrinkle during winding,” as well as providing brand identification and/or written marketing, instructional or advertising material. Providing brand identification and/or written marketing, instructional or advertising material can be placed on a smooth or rough surface. Accordingly, there would be no reason to form a rough surface on Gotoh’s film for this reason.

A person skilled in the art would not have been motivated to form a rough surface on Gotoh’s film to prevent blocking or wrinkling, as disclosed in Harvie. Specifically, Gotoh’s film already prevents blocking and wrinkling when unwinding, without the need for a release agent. There would be no reason for a skilled artisan to look to Harvie’s teachings to prevent blocking and wrinkling in Gotoh, since Gotoh presumably does not suffer from such problems — Gotoh already solved this problem in a different manner. Accordingly, a person skilled in the art would not have combined Gotoh and Harvie in the manner combined in the Action.

In sum, Gotoh fails to disclose a masking film that either is not an adhesive coating, or does not have an adhesive coating applied thereto. Gotoh also fails to suggest application of its masking film to a textured surface. Finally, a person skilled in the art would not have combined Gotoh and Harvie, as alleged in the Action. Accordingly, the combined teachings of Gotoh and Harvie fail to render obvious the present claims. Applicants therefore respectfully request that the Examiner reconsider and withdraw this rejection.

extruding with a base, or supporting film (*see*, all of the examples that disclose co-extrusion — the polyolefin base film typically is 5-10 times thicker than the adhesive coating).

On pages 6 and 7 of the Action, claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Gotoh in view of Harvie as applied to claim 1 above, and further in view of Okumura, *et al.*, U.S. Patent No. 6,407,788 ("Okumura"). Applicants respectfully traverse this rejection for the same reasons noted above. That is, the combination of Gotoh and Harvie fail to render obvious independent claim 1. Any combination of Gotoh and Harvie, with Okumura likewise will fail to render obvious independent claim 1, as well as any claims dependent thereon, such as claim 5. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection.

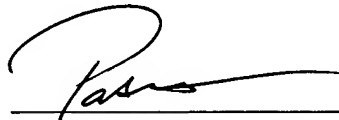
Applicants respectfully submit that the present claims are in condition for allowance. Applicants earnestly solicit an early notice to this effect. Should there be any questions concerning the foregoing, Applicants invite Examiner Bruenjes to contact the undersigned at the telephone number listed below.

In the event any variance exists between the amount enclosed and the PTO charges, please also charge or credit any difference to Deposit Account No. 50-0206.

Respectfully submitted,

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